

REMARKS

The Office Action mailed October 19, 2007, has been received and reviewed. In the Office Action, claims 13-19, 33-39, 44-47, and 54-67 were pending in the subject application. Claims 18, 19, 36, and 39 are allowed and the remaining claims stand rejected. More specifically, claims 13-17 and 59-67 were rejected under 35 U.S.C. ¶ 1 as failing to comply with the written description requirement. Claims 13-17, 54-59, and 62-63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,131,208 to Banks (hereinafter the “Banks reference”) in view of U.S. Patent No. 5,515,551 to Yashiro (hereinafter the “Yashiro reference”). Claims 33-35, 37, 38, and 44-47, and 64-66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,341,863 to Chen-Lieh (hereinafter the “Chen-Lieh reference”). Reconsideration of the present application in view of the above proposed amendments and the following remarks is respectfully requested.

Allowable Subject Matter

Applicants would like to thank the Examiner for allowing claims 18, 19, 36, and 39. Further, Applicants would thank to thank the Examiner for indicating that claims 60, 61, and 67 would be allowable if rewritten in independent form including all of the limitations of the base claim. As set forth herein, the limitations of claim 60 have been incorporated into independent claim 59, along with the suggested amendment to overcome the 35 U.S.C. § 112 ¶ 1 rejection of that claim. Accordingly, Applicants respectfully submit that independent claim 59, and all claims depending from it, are currently in condition for allowance.

Similarly, the limitations of claim 67 (as well as the limitations from claim 65) have been incorporated into independent claim 64, along with the suggested amendment to overcome the 35 U.S.C. § 112 ¶ 1 rejection of that claim. Accordingly, Applicants respectfully

submit that independent claim 64, and all claims depending from it, are currently in condition for allowance. Claims 60, 65, and 67 have been canceled by way of the present proposed amendment, having been already incorporated into the corresponding independent claim.

Rejections based upon 35 U.S.C. § 112 ¶ 1

Claims 13-17 and 59-67 were rejected under 35 U.S.C. 112 ¶ 1 as failing to comply with the written description requirement. Per the Examiner's suggestion, independent claims 13, 59, and 64 have been amended herein to remove the limitation that the annular peripheral wall is transparent. As amended, Applicants believe that each of independent claims 13, 59, and 64, as well as those claims depending therefrom, overcome the 35 U.S.C. 112 ¶ 1 rejection. Thus, withdrawal of the 35 U.S.C. § 112 ¶ 1 rejection of claims 13-17 and 59-67 is respectfully requested.

Rejections based upon 35 U.S.C. § 103(a)

Title 35 U.S.C. § 103(a) declares a patent shall not issue when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestion or motivation found either in the prior art references themselves or in the knowledge generally available to one

of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957 (1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

Claims 13-17, 54-59, and 62-63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Banks reference in view of the Yashiro reference. As the Banks reference and the Yashiro reference, either alone or in combination, fail to teach or suggest all of the claim limitations of claims 13-17, 54-59, and 62-63, Applicants respectfully traverse this rejection as hereinafter set forth.

Independent claim 13, as proposed to be amended herein, recites swim goggles comprising, in part, a pair of unconnected eye pieces wherein each eyepiece includes an adhesive layer that adhesively secures the eyepiece to the skin of a user in close proximity to the eye so as to form a substantially water-tight seal around the eye that substantially isolates the eye from the

surrounding environment during use. This is in contrast to the sun-bed goggles disclosed in the Banks reference. The Banks reference does disclose using an adhesive to adhere the sun-bed goggles to the area around a user's eye to block UV radiation. *See Banks reference* at Col. 2, l. 23 – Col. 3, l. 36. But the Banks reference fails to teach or suggest adhesively securing an eyepiece to form a water-tight seal. Just as a brimmed hat protects attaches to a user's head to protect a user's face from UV radiation, the sun-bed goggles of the Banks reference attach to a user's face to protect the user's eyes from UV radiation. A brimmed hat, however, is not the same as a shower cap that creates a water-tight seal around a user's head. Nor are the sun-bed goggles of the Banks reference the same as the swim goggles of claim 13 because, although the adhesion may protect from UV radiation, the adhesion fails to provide for a water-tight seal. The deficiencies of the Banks reference are not cured by the addition of the Yashiro reference because the Yashiro reference fails to teach or suggest adhesively securing an eyepiece to the skin of a user in close proximity to the eye to form a substantially water-tight seal round the eye. *See generally Yashiro reference.*

Accordingly, Applicants respectfully submit that the Banks reference and the Yashiro reference, either alone or in combination, fail to teach or suggest the elements as recited by independent claim 13, as proposed to be amended herein, under 35 U.S.C. § 103(a). Thus, claim 13 is patentable over the Banks reference and the Yashiro reference. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested.

Independent claim 59, as proposed to be amended herein, incorporates the allowable subject matter from claim 60, as previously discussed with respect to allowable subject matter. Accordingly, Applicants respectfully submit that the Banks reference and the Yashiro reference, either alone or in combination, fail to teach or suggest the elements as recited by

independent claim 59, as proposed to be amended herein, under 35 U.S.C. § 103(a). Thus, claim 59 is patentable over the Banks reference and the Yashiro reference. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested.

As the Banks and the Yashiro references, either alone or in combination, fail to teach or suggest each of the limitations of independent claims 13 and 59, it is respectfully submitted that these claims are patentable over the combination of the Banks and Yashiro references. Each of claims 14-17, 54-58, and 62-63 depends, either directly or indirectly, from one of independent claims 13 and 59 and is, thus, patentable over the Banks reference in view of the Yashiro reference for at least the reasons stated above. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of each of these claims is respectfully requested.

Claims 33-35, 37, 38, 44-47, and 64-66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Chen-Lieh reference. As the Chen-Lieh reference fails to teach or suggest all of the claim limitations of independent claims 33, 37, 44, and 64, Applicants respectfully traverse this rejection as hereinafter set forth.

Independent claims 33, 37, and 44, as proposed to be amended herein, each include a limitation directed to forming a water-tight seal with an adhesive layer that adhesively secures the body of the goggles to the skin of the user in close proximity to the eye. As previously discussed, the Banks and Yashiro references, either alone or in combination, fail to teach or suggest this limitation. Similarly, the Chen-Lieh reference, which discloses a diving mask that covers both eyes and the bridge of the nose and portions of the face of the user while in the in-use position, fails to teach or suggest a water-tight seal formed with an adhesive layer. Accordingly, Applicants respectfully submit that the Chen-Lieh reference fails to teach or suggest the elements as recited by independent claims 33, 37, and 44, as proposed to be amended

herein, under 35 U.S.C. § 103(a). Thus, claims 33, 37, and 44 are patentable over the Chen-Lieh reference. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of these claims is respectfully requested.

Independent claim 64, as proposed to be amended herein, incorporates the allowable subject matter from claim 67 (as well as the limitations from claim 65), as previously discussed with respect to allowable subject matter. Accordingly, Applicants respectfully submit that the Chen-Lieh reference fails to teach or suggest the elements as recited by independent claim 64, as proposed to be amended herein, under 35 U.S.C. § 103(a). Thus, claim 64 is patentable over the Chen-Lieh reference. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested.

As the Chen-Lieh reference fails to teach or suggest each of the limitations of independent claims 33, 37, 44 and 64, it is respectfully submitted that these claims are patentable over the Chen-Lieh reference. Each of claims 34-35, 38, 45-47, and 66 depends, either directly or indirectly, from one of independent claims 33, 37, 44, and 64 and is, thus, patentable over the Chen-Lieh reference for at least the reasons stated above. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of each of these claims is respectfully requested. Claim 65 has been canceled by way of the present amendment and, thus, the rejection of this claim has been rendered moot.

CONCLUSION

For at least the reasons stated above, claims 13-19, 33-39, 44-47, and 54-67 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or jgibson@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

/John E. Gibson/

John E. Gibson
Reg. No. 52,944

JEG/AJKX

SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550